

REMARKS

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

In the Office Action, Claims 1-7 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al. (USP 5,740,549). Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly in view of Hunt et al. (USP 5,893,091). Applicants respectfully traverse and request the Examiner to consider the following remarks.

Legal Principles

Certain well established principles must be observed in assessing whether or not an invention is patentable under 35 U.S.C. 103(a). First, the claims of a patent, which define the invention, are "to be construed in light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). The "differences between the prior art and the claims at issue are to be ascertained." Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Moreover, it is elementary that the claimed invention must be considered as a whole in deciding obviousness. Litton Industrial Products, Inc. v. Solid State Systems Corp., 755 F. 2d 158, 164, 255 USPQ 34, 38 (Fed. Cir. 1985). The prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc v. Barnes-Hind/Hydrocurve, Inc., 796 F. 2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986), In re Hedges, et al., 783 F. 2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). Moreover, "[t]he mere fact that the prior art could be ... modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis supplied.) In re Gordon, 733 F. 2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) which cites with approval Carl Schneek, A. G. v. Nortron, Corp., 713 F. 2d 782, 787, 218 USPQ 698, 792 (Fed. Cir. 1983) and In re Sernaker, 702 F. 2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir.

1983), both citing In re Imperato, 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). In accord, In re Laskowski, 871 F. 2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Establishing a *prima facie* case of obviousness requires that the prior art give reason or motivation to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert denied, 500 U.S. 904 (1991). (Emphasis supplied.) Second, there must be a reasonable expectation of success. Third, the references when combined must teach or suggest all the claim limitations. MPEP 2141. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (1991).

The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the modification. MPEP 2143 (emphasis supplied).

Finally, it is impermissible to first ascertain factually what the inventor did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention from such prior art. Panduit Corp. v. Dennison Manufacturing Co., 774 F. 2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). (Emphasis supplied.)

Applying these principles to the invention as embodied in the present claims and to the Reilly and Hunt references, the Applicants respectfully submit that a proper reading of the references fails to disclose or suggest the invention embodied in the present claims.

The Reilly Patent

Reilly discloses an information distribution system where an information server stores and updates a database of information items and advertisements. The information items and advertisements are each categorized so that each has an associated information category. The information server then downloads information to one or more client workstations, which include a profiler for storing subscriber profile data.

Applying the Reilly Reference to Claims 1-7 and 10-20

In order to establish a *prima facie* case of obviousness, controlling authority mandates that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Reilly patent fails to teach or suggest limitations of the independent claims 1, 10, 14 and 18. Specifically, the Reilly patent fails to teach or suggest a “networked information monitor,” which was referred to as “a fully configurable frame with one or more controls; the frame through which content is optionally presented” in the specification. The Applicants respectfully submit the Reilly patent also fails to teach or suggest anything that can be reasonably interpreted to be a “networked information monitor”, or NIM, of the present invention. Therefore, the rejections under 35 U.S.C. § 103(a) cannot stand because the Reilly patent does not teach all limitations of the rejected claims.

In Reilly, an information server stores and updates a database of information items and advertisements. Workstations remotely located from the information server store information received from the information server based on at least one profiler for storing subscriber profile data. In Reilly, profiler 206 defines and updates a subscriber's user profile. The profiler in Reilly is associated with and identifies a computer to define a registered subscriber (Col. 7, lines 50-55), and this profiler is stored in a memory of the workstation or computer (e.g., see Figure 2). Because the profiler is specific to a computer or workstation, any preferences set by an individual at a computer is specific to the computer or workstation. If the individual were to log on a second computer, the preferences associated with the second computer would dictate the information presented to the user. Similarly, if a second user were to log on the workstation, the profile of the workstation would define the information provided to the second user.

The present invention is quite different and non-obvious with respect to Reilly. In the present invention, when a client logs in to a computer network, the client receives the user profile, with collected NIM definitions (see Figure 12) from an application server. In this way, NIM information and controls for managing and handling internet content is not stored on a

client device but instead is stored remotely from the client device. On the other hand, Reilly stores profile information on the client computer. This significant distinction results in a completely different system where user profiles are associated with the user and not workstations.

For example, Reilly requires an information server remote from the user client where an information editor maintains a list of currently defined or added categories. In contrast, the user of the present invention is permitted to select, categorize or group NIMs in any way desired by the user, and such selections, preferences, categorizations and groupings are associated with user and not the workstation. As a result, a user can log on to a second workstation and have information presented in accordance with user-defined, and not workstation, preferences. At the same time, in the present invention multiple users can access the same workstation and have information presented to each differently from others in accordance with their user-defined preferences.

The NIMs of the present invention are not found at all in Reilly, and Reilly in no way provides the user features and functionality of the of the present invention. For example, with respect to claim 1, Reilly does not identify the delivery of a set of NIMs, track information about each NIM or determine subsets of NIMs. As NIMs (or NIM features or functionality) are not found in and cannot be provided by Reilly, there is no way that Reilly can perform the steps of independent claims 1, 10 and 18.

not claimed
For example, in the present invention, a home NIM coordinates the activities of all other NIMs accessed by a user and allows the user to review, package and distribute multiple sources of media. The Applicants respectfully submit that the Examiner's suggestion that the delivery of a set of NIMs can be categories as in Reilly is incorrect as such categories cannot be reviewed, packaged and distributed by client users as in the present invention, and the Applicants submit that such a functional distinction would not at all have been obvious to one skilled in the art.

Additionally, the Examiner notes with respect to claim 1 that "Reilly does not specifically disclose that tracking information is collected when the user opens and closes a selected NIM." Instead the Examiner notes that "viewing preferences" are collected. In view that the Examiner

notes that Reilly does not specifically disclose that tracking information is collected when the user opens and closes a selected NIM and further in view that the "viewing preference" collected in the present invention differs from Reilly (as discussed above), the Applicants submit that claim 1 is allowable in view of the cited art.

With respect to dependent claims 2-7, the same reasons given for claim 1 apply, as the claimed aspects are not found in Reilly.

With respect to independent method claim 10, when a client logs in to a computer network, the client receives the user profile, with collected NIM definitions (see Figure 12). This significant distinction results in a completely different system from Reilly where user profiles are associated with the user and not workstations. As a result, Reilly does not perform the steps associated with claim 10. For instance, Reilly does not perform the step of identifying the delivery of a NIM to a user since Reilly links the delivery of information to workstations. For the same reason, Reilly does not perform the step of "tracking NIM use by said user".

Similarly, with respect to the steps of dependent claims 11-13, Reilly does not perform such steps directed to the user. Accordingly, the Applicants submit that dependent claims 11-13 are allowable. As an alternative ground for allowance, claims 11-13 are dependent on claim 10, which is allowable.

With respect to claims 14-20, the similar arguments above apply.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

In the Office Action, claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly and further in view of Hunt. Applicants respectfully traverse and request the Examiner to consider the following remarks.

The Hunt Patent

The Hunt patent broadcasts organized information to end users in the form of alerts over a plurality of alert channels.

App. No. 09/558,924
Response dated: January 5, 2004
Reply to Office Action of September 5, 2003

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Enclosure

Applying the Reilly and Hunt References to claims 8 and 9

With respect to claims 8 and 9, the Hunt patent similarly fails to teach or suggest a NIM in the specification. The Applicants respectfully submit the Hunt patent also fails to teach or suggest anything that can be reasonably interpreted to be a NIM of the present invention separately or in conjunction with Reilly. Thus, for the same reasons as given for Reilly, the rejections under 35 U.S.C. § 103(a) cannot stand because the Hunt patent in view of Reilly does not teach all limitations of the rejected claims. Thus, claims 8 and 9, these claims are allowable.

As an alternative ground for allowance, claims 8 and 9 are dependent on claims 1, which is allowable.

OBJECTION

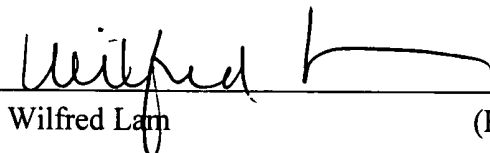
The Examiner has requested a substitute specification including the claims. The Applicants will provide a substitute specification that conforms to 37 CFR 1.52(1)(ii) where the top margin is at least 2 inches. The Applicants request that the Examiner permit the Applicants to place the objection in abeyance until the issues of patentability have been resolved.

CONCLUSION

In light of the above, Applicants respectfully submit that the pending claims are allowable. Applicants believe a telephone interview would help clarify issues of the present application and advance prosecution of this case, and respectfully request the Examiner to contact the undersigned attorney to set up a mutually convenient time for a telephone interview.

Respectfully submitted,

Date January 5, 2004



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